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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/772,785	01/30/2001	James F. Ziech	60680-491	1549

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EXAMINER

TO, TOAN C

ART UNIT	PAPER NUMBER
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3616

DATE MAILED: 12/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/772,785

Applicant(s)

ZIECH ET AL.

Examiner

Toan C To

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 and 20-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4,5,9,10,12,16,20 and 22 is/are allowed.
- 6) ☒ Claim(s) 1-3,6-8,11,13-15,17,18,21 and 23-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 11 October 2002 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Request for Continuation Examination (RCE)

1. The Request for Continuation Examination filed on September 16, 2003 under 37 CFR 1.114 based on parent Application No. 09/772,785 is acceptable and a RCE has been established. An action on the RCE follows.

Information Disclosure Statement

2. The information disclosure statement filed September 16, 2003 fails to comply with 37 CFR 1.98(a)(1), which requires a list of all patents, publications, or other information submitted for consideration by the Office. It has been placed in the application file, but the information referred to therein has not been considered.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3, 13-15, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Berckhan (U.S. 3,243,007).

As to claims 1, and 13, Berckhan discloses a sub-frame assembly with the following: a first and second cross members (23, 24) being integral with a first and second side members (29, 30) so as to form a unitary member; wherein the first and second side members and the first and second cross members configured to receive

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first and second lower suspension control arms (60), and first and second upper suspension control arms (59).

As to claims 2, and 14, Berckhan discloses a sub-frame assembly with the following: wherein the first and second cross members (23, 24) are configured to receive the first and second lower suspension arms (60).

As to claims 3, and 15, Berckhan discloses a sub-frame assembly with the following: wherein the first and second side members (29, 30) configured to receive first and the first and second upper suspension control arms (59).

As to claim 17, Berckhan discloses a sub-frame assembly with the following: a strut rod (61) having a first end couple to the subframe and second coupled to a vehicle frame rails (11).

As to claim 18, Berckhan discloses a sub-frame assembly with the following: a steering linkage (70) coupled to the subframe.

5. Claims 6-8, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Berckhan (U.S. 3,243,007).

As to claims 6, and 11 Berckhan discloses a sub-frame assembly with the following: a first and second cross members (23, 24) being integral with a first and second side members (29, 30); wherein, the first and second cross members (23, 24) and the first and second side members (29, 30) are configured to receive first and second lower suspension control arms (60), first and second upper suspension control arms (59) and idler arm (69) of a steering linkage (70).

As to claim 7, Berckhan discloses a sub-frame assembly with the following:
wherein the first and second cross members (23, 24) are configured to receive the first and second lower suspension arms (60).

As to claim 8, Berckhan discloses a sub-frame assembly with the following:
wherein the first and second side members (29, 30) configured to receive first and the first and second upper suspension control arms (59).

6. Claim 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Roethlisberger (U.S. 4,057,120).

Roethlisberger discloses a sub-frame assembly with the following: a first and second cross members (12, 14) connected to a first and second side members (16, 17); wherein, the first and second cross members (12, 14) and the first and second side members (16, 17) are configured to receive first and second lower suspension control arms (20, 34), first and second upper suspension control arms; wherein, the first and second lower suspension control arms (34), first and second upper suspension control arms (34) form an independent front suspension for the vehicle.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 23-25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Berckhan.

Berckhan discloses every element of the invention as discussed above except the following: wherein, the first and second side members and the first and second cross members are integrally formed by casting.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to build the subframe of Berckhan by different processes such as process of casting such that the first and second cross members and the first and second side members are integrally formed a unitary member in order to increase strength of the subframe and sufficiently support the suspension of the vehicle.

Response to Arguments

9. Applicant's arguments filed April 02, 2003 have been fully considered but they are not persuasive.

In response to applicant argument that Berckhan does not disclose "first and second cross members integral with said first and second side members so as to form a unitary member", the examiner respectfully disagrees because the following reasons:

(1) In re Hotte, (CCPA) 177 USPQ 236, states that "integral is sufficient broad to embrace constructions united by such means as fastening and welding", in this case, Berckhan (column 2, lines 25-65) discloses first sides of struts 25-28 are welded to the first and second side members 29, 30 while the other sides of struts 25-28 are welded to the first and second cross members 23-24, in other word, after welding process, the first and second sides 29-30, the first and second cross members 23-24, and the struts 25-28 are formed as one piece or a unitary. Further, with respect to applicant's

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illustration regarding the contrast between the subframe as claimed and the prior art, stating:

"the side members 98, 100.....there are no bolts, welds or other fasteners required to build subframe 62"

It is noted that the features upon which applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Therefore, the examiner broadly interprets that the broad limitations as recited in the claims read on the subframe as disclosed by Berckhan.

In response to applicant's argument regarding patentability of claims 23-25, it is noted that claims 23-25 are product-by-process claims, and MPEP. 2113 states that

"The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process."

In view of the above statement, the subframe of the present invention is same as or obvious from the subframe as disclosed by Berckhan; therefore, the subframe as claimed is considered to correspond to the subframe of Berckhan.

Allowable Subject Matter

10. Claims 4-5, 9-10, 12, 16, 20, and 22 are allowed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Toan To whose telephone number is (703) 306-5951. The examiner can normally be reached on Monday-Friday from 8:00 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Dickson, can be reached on (703) 308-2089. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-2571. Any inquiry of a general nature or relating to the status of this application or this application or proceeding should be directed to the receptionist whose telephone number is (703)305-1113.

To, T

November 26, 2003